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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/614,861	07/09/2003	Yasuo Inoue	29284/596	8144
7590	11/29/2004			
KENYON & KENYON Suite 700 1500 K Street, N.W. Washington, DC 20005			EXAMINER CHEN, ALAN S	
			ART UNIT 2182	PAPER NUMBER

DATE MAILED: 11/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/614,861	INOUE, YASUO	
	<b>Examiner</b>	<b>Art Unit</b>	
	Alan S Chen	2182	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 1-53 is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 09 July 2003 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All
  - b) Some \*
  - c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_.

**DETAILED ACTION*****Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-14 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of application #s: 10/614859, 10/614860, 10/614862, 10/614863, 10/614864. Although the conflicting claims are not identical, they are not patentably distinct from each other because applicant recites limitations that are based on the general premise of the instant application that each functional unit requires a minimum number of paths required to connect to associated functional units, e.g., the number of paths is equivalent to the number of associated functional units needed to be connected to.

***Claim Objections***

2. Claim 11 objected to because of the following informalities: left out the word "drives" in line two after "plurality of disk". Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 1 recites the limitation "plurality of channel units" in lines 4 and 5. There is insufficient antecedent basis for this limitation in the claim. Examiner interprets applicant to mean "said channel unit", not "said plurality of channel units".

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-53 rejected under 35 U.S.C. 103(a) as being unpatentable over No. 5,247,638 to O'Brien et al. (hereafter O'Brien) in view of No. 5,526,482 to Stallmo et al. (hereafter Stallmo).

8. As per claim 1, O'Brien discloses a storage system comprising: a channel units (Fig. 1, any one of elements 110-n or Fig. 2, element 201-n) that transfers data sent from an upper-level system (Fig. 1, element 11) and transfers data to said upper-level system (see abstract), a cache unit (Fig. 1, element 113) which is connected to said channel unit (Fig. 2, element 113 is connected to element 110) and in which data sent from said

channel unit is stored (Column 7, lines 46-65); a plurality of control units (Fig. 1, element 111 and 112) that is connected to said cache unit (Fig. 1, element 113), and transfers or receives data to or from said cache unit (Fig. 2); a disk device in which data sent from said plurality of control units is stored (Fig. 1, element 102-1), and a plurality of paths (Fig. 1, paths between element 111, 112 and element 113) connecting each control unit to said cache unit.

O'Brien does not disclose expressly a plurality of cache units where the plurality control units connect to each of the plurality of cache units using a plurality of paths.

Stallmo discloses a storage system in Fig. 1, where a plurality of cache elements exists for the purpose of fault tolerance (CC in Fig. 1 is the copyback cache storage unit, a plurality of which exists for the purpose of mirroring other CCs for fault tolerance, Column 6, lines 40-55). Stallmo also discloses the storage system being implemented as among a multiple disk devices (Fig. 1, element 7) and the data being received from a host (Fig. 1, element 1).

O'Brien and Stallmo are analogous art because they are from similar problem solving area in data storage systems where data is transferred from an upper level system through an intermediate system and stored on multiple disk devices.

At the time of the invention it would have been obvious to a person of ordinary skill in the art to implement multiple caches to be attached to the plurality of control units.

The suggestion/motivation for doing so would have been to provide fault tolerance to data traversing between the host and the disk drives such that if one cache fails, another can be accessed for the missing data (Stallmo, Column 6, lines 40-55). This

is particularly significant in high cache access systems such as shown in O'Brien, where a plurality of hosts send data to be stored in the disk drives, thereby further increasing cache utilization rates.

Therefore, it would have been obvious to combine O'Brien with Stallmo for the benefit of fault tolerance provided by multiple cache units.

9. As per claims 2-10, 12, 15-53, O'Brien combined with Stallmo discloses claim 1 wherein Stallmo further discloses the connection path between the each control unit and each cache being separate and independent since each cache is physically separate from each other and the channel unit, requiring a separate physical path to connect each cache to the channel unit (Fig. 1, element 2, 5 and 6 of O'Brien and Fig. 1, independent bus lines shown connecting cache and control/channel unit of Stallmo). In addition, for fault tolerance, independent and paths further mitigate chances of failure. It is clear that for all paths to be independent, there must be a path going from each source unit to each the destination units yields a path sum being equal to the number of control units and number cache units.

10. As per claim 11, O'Brien combined with Stallmo discloses claim 1, wherein O'Brien and Stallmo further discloses said disk device includes a plurality of disk drives (Fig. 1, element 122-125 of O'Brien and Fig. 1, element 7 of Stallmo), and said plurality of control units is connected to said plurality of disk drives (Fig. 1, element 121 of O'Brien and Fig. 1, element 3 of Stallmo).

11. As per claims 13 and 14, O'Brien combined with Stallmo discloses claim 1, wherein O'Brien further discloses the said plurality of paths are signal lines linking said cache unit and said control units that enable the upper-level system to communicate with

the disk device which entails reading and writing data to and from the cache. (Fig. 3 of O'Brien, bi-directional nature of the buses between the channel unit and the cache).

***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents are cited to further show the state of the art with respect to data storage device that interface a host via cache, controllers:

U.S. Pat. No. 5,131,087 to Warr

U.S. Pat. No. 5,253,351 to Yamamoto et al.

U.S. Pat. No. 5,263,145 to Brady et al.

U.S. Pat. No. 4,633,387 to Hartung et al.

U.S. Pat. No. 4,603,380 to Easton et al.

U.S. Pat. No. 5,175,842 to Totani

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alan S Chen whose telephone number is 571-272-4143. The examiner can normally be reached on M-F 8:30am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A Gaffin can be reached on (571) 272-4146. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2182

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ASC  
11/23/2004

KIM HUYNH  
**PRIMARY EXAMINER**

11/23/04